

## **REMARKS**

### **A. Overview**

The Office Action rejects claims 1-11, 13-18, and 20 under 35 U.S.C. § 102(b) over U.S. Patent Publication No. 2001/0042002 by Koopersmith ("Koopersmith"), and rejects claims 12 and 19 under 35 U.S.C. § 103(a) over a combination of Koopersmith and U.S. Patent No. 7,050,989 to Hurt et al.

Claims 1-20 were pending when the Office Action was mailed on September 20, 2007. In this response, applicant amends claims 1, 6, 8, and 16; cancels claim 9; and presents new claims 21-24 to more clearly identify the subject matter for which applicant seeks protection. Accordingly, claims 1-8 and 10-24 are currently pending. For the reasons set forth in detail below, applicant submits that the application is in condition for allowance.

### **B. Objection to Claim 8**

The Office Action objects to claim 8 because of informalities. While applicant does not concur in the propriety of this objection, to advance examination, applicant herein amends claim 8 to recite "the collection of search terms includes...." Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this objection.

### **C. Rejections under 35 U.S.C. § 102(b)**

The Office Action rejects claims 1-11, 13-18, and 20 under 35 U.S.C. § 102(b) over Koopersmith. Koopersmith is generally directed to communicating information to users based on demographic profiles and user inquiries. More specifically, Koopersmith distributes advertising materials to users who have expressed an interest in the advertised product or service. (Koopersmith, paragraphs [0027], [0118]). A server stores advertising materials collected from advertising entities and demographic data collected from users. (Koopersmith, paragraphs [0027], [0118]). Users submit search terms, or "inquiries" to the server, which scans a database for relevant materials and filters the results based on demographic data. For example, if a user searched for "sports equipment retailers," and

the user's demographic profile indicated that the user was not interested in golf, the server could filter out all advertisements for retailers that only sold golf equipment. Each time a user performs an inquiry, the server searches the database and filters results to determine what information to present. The terms included in the inquiry are not associated with advertising materials before a user submits the inquiry to the server.

In contrast, applicant's technology stores associations of search terms and advertisements and uses these associations to associate users with advertisements based on the search terms they employ. The association of users and advertisements assists in determining which advertisements to display to a user as the user moves around the internet. For example, when a user searches for "nine iron," the user may be associated with an advertisement for golf equipment if there is a pre-stored association of "nine iron" and golf equipment. Each time there is an opportunity to present an advertisement to a user, regardless of the website the user is accessing, the association of golf equipment with the user may determine which advertisement to display.

Claim 1 now recites "in response to the user visiting a publisher web site at a time subsequent to the association of the web search term with the advertisement, determining if the user has employed the search term." Koopersmith fails to disclose this feature. The Office Action points to paragraph [0092] and Fig. 6 in Koopersmith as describing "associating a web search term with the advertisement, such that users employing the term in a search are desired recipients of the advertisement." (Office Action, pages 2-3). In Koopersmith, an inquiry is associated with advertising materials after submission to the server, associations are not stored ahead of time. The fact that materials are transmitted to the user in response to the inquiry creates the association. In applicants' claimed technology, an association between search terms and advertisements exists prior to the user's employment of the search terms. Therefore, claim 1 is patentable over Koopersmith as are its dependent claims 2-5, 21, and 22.

Claim 6 now recites:

"based on the collected search terms, assigning each user to a selected advertising strategy by comparing a set of search terms associated with an advertisement to the search terms collected for the user and if the user has employed any of the search terms, assigning the user to an advertising strategy that includes serving the advertisement to the user; and in response to a user visiting a publisher web site, after the user is assigned to a selected advertising strategy, enacting the selected advertising strategy."

Similarly, claim 16 now recites:

"assigning identifiers associated with one of the desired search terms to an associated one of the advertising strategies; and in response to a user visiting a publisher web site, determining the user's unique identifier, searching the database to determine an advertising strategy previously assigned to the user's unique identifier, and serving an advertisement to the user based on the strategy."

Koopersmith does not disclose these features. In Koopersmith, an advertising strategy is applied to a user when the user expresses an interest in a product or service. (Koopersmith, paragraph [0118]). Koopersmith deems a user to have expressed interest in a product or service if the user requests information about the product or service, if the user requests the server to purchase the product or service, or if the user's demographic profile indicates that the user is interested. (Koopersmith, paragraph [0118]). When an advertising strategy is associated with the user based on a request for information, the association occurs after the user submits the request. The association is not established before the user visits the site. Koopersmith contains no indication that, when the association is based on a request to purchase a product or service, it considers the search terms the user has employed. Similarly, when associating an advertising strategy with a user based on a user's demographic profile, Koopersmith does not consider the search terms the user has previously employed. The Office Action points to Koopersmith paragraph [0123] as describing "collecting search terms employed by search user." (Office Action, page 3). Applicant respectfully disagrees. This portion of Koopersmith describes a "life management" function that provides timely suggestions to a user, such as a gift for an

upcoming anniversary, which is unrelated to collecting search terms a user employs as recited. Thus, claims 6 and 16 are patentable over Koopersmith, as are their dependent claims 7, 8, 10-15, 17-20, 23, and 24.

D. Conclusion


As discussed above, the pending application is in condition for allowance. Accordingly, applicant earnestly solicits a prompt notice of allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 418268719US from which the undersigned is authorized to draw.

If the Examiner has any questions, or believes a telephone conference would expedite examination of this application, the Examiner is encouraged to call the undersigned at (206) 583-8888.

Dated: *December 12*, 2007

Respectfully submitted,

  
By \_\_\_\_\_  
Steven D. Lawrenz  
Registration No.: 37,376  
PERKINS COIE LLP  
P.O. Box 1247  
Seattle, Washington 98111-1247  
(206) 359-8000  
(206) 359-7198 (Fax)  
Attorney for Applicant